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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/934,254 09/19/97 THOMAS

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EXAMINER

MCELWAIN, E

ART UNIT

PAPER NUMBER

1638

DATE MAILED:

07/05/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/934,254**

Applicant(s)

**Thomas**

Examiner  
**Elizabeth McElwain**

Group Art Unit  
**1638**



☒ Responsive to communication(s) filed on Apr 14, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-14, 18-35, and 47-49 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 1-14, 19-21, and 24-31 is/are allowed.

☒ Claim(s) 18, 22, 23, 32-35, and 47-49 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1638.

The amendment filed April 14, 2000 has been received and entered.

5        Claims 15-17 and 36-46 have been cancelled.

Claims 11-14, 22 and 32-35 are newly amended.

Claims 47-49 are newly submitted.

Applicants' representative was called on June 27 and June 30, 2000 to attempt to make the application in condition for allowance. However, applicants' representative was unable to reach their client for approval of the suggested claim amendments. Therefore, the following rejections and suggestions for claim amendment are set forth.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

15        Claims 18, 22, 32-35 and 47-49, and claim 23 dependent thereon, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 is indefinite in that it is unclear if the transgenic bacterium or plant that is claimed is transgenic due to transformation of said organism with the nucleic acid of one of claims 1-3. Amendment of the claim to recite “, wherein said nucleic acid is operably linked to a heterologous regulatory region”, for example.

Claims 22 and 47-49 are indefinite in that it remains unclear if the progeny and regenerated plants would retain the nucleic acid encoding the desaturase and/or any traits conferred by expression of said desaturase gene. Amendment of the claims to read “, wherein said plant comprises in it’s genome said isolated nucleic acid” would overcome the rejection.

5           Claims 32-35 are indefinite in that they are unduly alternative.

10           Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth F. McElwain whose telephone number is (703) 308-1794. The examiner can normally be reached on Tuesday through Friday from 7:30 AM to 5:00 PM. The examiner can also be reached on alternate Mondays.

15           If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached at (703) 308-4310. The fax phone number for this Group is (703) 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

20           Elizabeth F. McElwain, Ph.D.  
June 30, 2000

ELIZABETH F. McELWAIN  
PRIMARY EXAMINER  
GROUP 1800

